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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/732,986	05/13/85	DUSZA J	29,995

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EXAMINER	
KAFNER, S	
ART UNIT	**PAPER NUMBER**
122	2

DATE MAILED: 11/22/85

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARK

11/22/85

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 1-19 are pending in the application.
   Of the above, claims 15-17 and 19 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1-14 and 18 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

PTOL-326 (Rev. 7-82) **EXAMINER'S ACTION**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-18, drawn to compounds, compositions and a method of use, classified in Class 544, subclass 281 and Class 514, subclass 258.

II. Claim 19, drawn to a process for making the compounds, classified in Class 544, subclass 281.

In the event that the invention of group I is elected, a single method of use must be chosen.

The inventions are distinct, each from the other, because of the following reasons:

Inventions I and II are related as process of making and product made.

The inventions are distinct if either (1) the process as claimed can be used to make another and materially different product, or (2) the product as claimed can be made by another and materially different process. MPEP 806.05(f).

In this case, the product as claimed can be made by a materially different process such as that described in Dugza '422.

The inventions of group I, claims 14-17 are distinct because the product may be used in four materially different processes as set forth in claims 14-17. See MPEP 806.05(h).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject

matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Susan H. Rauch on November 6, 1985 a provisional election was made with right of traverse to prosecute the invention of group I, claims 1-14 and 18. Affirmation of this election must be made by applicant in responding to this Office action. Claims 15-17 and 19 are withdrawn from further consideration by the examiner as being drawn to a nonelected invention. See 37 CFR 1.142(b).

The method of use of claim 14 was elected.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Claims 1-14 and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the prior invention as set forth in claims 1-31 of U.S. patent no. 4,521,422. Although the conflicting claims are not identical, they are not patentably distinct from each other because the distinction between the R_4 substituents claimed instantly and the R_1 groups of '422 is not deemed patentable.

Claims 1-14 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 and 18 of copending application serial no. 732,985. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences in substituents between R_1 in 732,985 and R_4 instantly are not deemed patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of monopoly by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Copies of references are not provided since they are applicants own and are therefore presumed to be easily obtainable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Kapner whose telephone number is (703) 557-3979.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 557-3920.

SK
Kapner:ce
11-13-85

Mark L. Bell
Primary Examiner
Art Unit 122